

REMARKS

The Office Action of March 4, 2004 has been reviewed and its contents carefully noted. Reconsideration of this case, as amended, is earnestly requested. Claims 1-22 remain in this case, independent claims 1, 8 and 15 being amended, and new claim 22 being added by this Response. The amendment of claims 1, 8 and 15 and new claim 22 are supported by the drawing and specification at page 5, lines 1-13, and generally throughout the specification and original claims; no new matter has been added.

The Examiner's attention is drawn to the attached Declaration of Richard A. Enos under 37 C.F.R. 1.132, providing evidence in rebuttal to the Examiner's factual assertions and providing additional evidence regarding secondary considerations of non-obviousness. The Examiner's consideration of the attached evidence of non-obviousness is respectfully requested.

A Petition and fee for a two-month extension of time under 37 CFR § 1.136 also accompany this Amendment, as well as payment of the fee for excess claims, due to the addition of new claim 22.

Allowable Subject Matter

Claims 7, 14 and 21 were objected to as being dependent upon a rejected base claim, but the Examiner indicated that they would be allowable, if rewritten in independent form, including all of the limitations of the base claim and any intervening claims, and claims 7, 14 and 21 are canceled in co-pending application Ser. No. 10/256,277.

Applicant gratefully acknowledges the Examiner's statement that claims 7, 14 and 21 are allowable. However, Applicant defers amendment at this time, as the rejections of the base claims are traversed (see below) and application Ser. No. 10/256,277 has become abandoned. Reconsideration and withdrawal of the objection to claims 7, 14 and 21 are therefore respectfully requested.

Information Disclosure Statement

The Examiner states that the Information Disclosure Statement fails to comply with 37 C.F.R. 1.98(a)(2), because it does not include printed copies of the cited U.S. patents. Therefore, the Examiner states that the cited references have not been considered.

Attached is a copy of the Official Notice whereby the USPTO has specifically waived the requirement under 37 C.F.R. 1.98(a)(2)(i) for submitting a copy of each cited U.S. patent for all national applications filed after June 30, 2003.

The present U.S. national application was filed on August 26, 2003, therefore the USPTO has specifically waived the requirement under 37 C.F.R. 1.98(a)(2)(i) for submitting a copy of each cited U.S. patent in this case. Applicant therefore respectfully submits that its previously-filed IDS is proper and respectfully requests the Examiner's consideration of the references cited therein.

Rejection under 35 U.S.C. § 102

Claims 1, 3, 6, 8 and 10 were rejected under 35 U.S.C. § 102 (b) as being anticipated by Crain (US 4,385,849). It is respectfully submitted that the rejection is overcome by the amendment of claims 1 and 8.

Applicant disagrees with the rejection, nevertheless, in order to advance prosecution of the application and to further clarify the claim language, independent claims 1, 8 and 15 are hereby amended to expressly recite that the claimed fastener is a **removable unitary assembly**.

In order to avoid rejection for anticipation, it is only necessary to show that a claim contains at least one element not disclosed in a single prior art reference. "Unless all of the same elements are found in exactly the same situation and united in the same way to perform the identical function in prior pleaded art, there is no anticipation." Stauffer v. Slenderella Systems of California, Inc., 254 F.2d 127, 115 USPQ 347 (9th Cir. 1957).

Applicant's independent claims 1, 8 and 15, as amended, recite, *inter alia*, a fastener comprising a **removable unitary assembly**, which is easily installed or removed as a complete unit (see, e.g., drawing and specification at page 5, lines 1-13). Crain does not disclose a fastener comprising a **removable unitary assembly** that is quickly and easily installed or removed as a one-piece (*i.e.*, "unitary") assembly. Rather, Crain discloses an extensible and retractable rod, comprising an outer tubular section and an inner section telescopically received in the outer section for extension and retraction relative thereto. The inner section has a stop at one end thereof engageable with the second shoulder of the outer section for limiting extension of the two sections relative to one another. The inner section may be releasably locked in an extended position relative to the outer section, by a detent pin 27 (constituting detent means) mounted in a diametrical bore 29 in **plug 15**, which is **affixed** at one end of the **inner** tubular section. Thus, the locking mechanism of Crain clearly is not a removable unitary assembly that is easily

installed or removed as a one-piece unit, rather, it is part of an internal plug, which is integral with and affixed inside the inner section of tubing. Indeed, the plug is affixed in place and entirely inaccessible, since it is located inside the end of the inner tube section, thus it is not removable.

Therefore, Crain does not anticipate Applicant's claims 1 and 8, because the reference does not disclose each and every limitation of the claims. Reconsideration and withdrawal of the rejection of independent claims 1 and 8 as being anticipated by Crain are thus respectfully requested.

Dependent claims 3, 6 and 10, being dependent upon and further limiting independent claims 1 and 8, should be allowable for the same reason, as well as the additional limitations recited therein. Reconsideration and withdrawal of the rejection of claims 1, 3, 6, 8 and 10 as being anticipated by Crain are therefore respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 4, 5, 11 and 12 were rejected under 35 U.S.C. § 103 (a) as being obvious over Crain (US 4,385,849), as applied to the section 102 rejection of claims 1 and 8 above.

Applicant respectfully disagrees, and maintains that the claims, as amended, are patentable over Crain, for the reasons given above in respect to the section 102 rejection of claims 1, 3, 6, 8 and 10. The argument above as to the novelty of claims 1, 8 and 15 is repeated here by reference.

It is respectfully submitted that the rejection is overcome by the amendment of claims 1 and 8. More particularly, Crain does not teach or suggest each and every limitation of Applicant's independent claims 1 and 8, because Crain does not disclose a fastener comprising a **removable unitary assembly** that is quickly and easily installed or removed as a one-piece (*i.e.*, "unitary") assembly, as noted above. Dependent claims 4, 5, 11 and 12, being dependent upon and further limiting independent claims 1 and 8, should be allowable for the same reason, as well as the additional limitations recited therein. Reconsideration and withdrawal of the rejection of claims 4, 5, 11 and 12 as being obvious over Crain are therefore respectfully requested.

Further, it is respectfully submitted that the Examiner has not met the initial burden of making a proper *prima facie* showing of obviousness. More particularly, in making the obviousness rejection, the Examiner asserts that one of ordinary skill in the art would be motivated to modify Crain and would have a reasonable expectation of success in making

Applicant's invention, however, the Examiner cites absolutely no authority in support of such factual assertions. If the Examiner's assertions are intended to indicate that the obviousness rejection is based on common knowledge in the art or "well known" prior art under MPEP 2144.03, then Applicant hereby traverses the Examiner's assertions.

BASIC CONSIDERATIONS UNDER 35 USC § 103

Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case. See generally Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966) and MPEP 2141. Office policy has consistently been to follow Graham v. John Deere Co. in the consideration and determination of obviousness under 35 U.S.C. § 103. Accordingly, examiners should apply the test for patentability under 35 U.S.C. § 103 set forth in Graham. MPEP 2141. The more objective findings suggested in Graham are drawn from the language of the statute and are fully adequate guides for evaluating the evidence relating to compliance with 35 U.S.C. § 103. Bowser Inc. v. United States, 388 F. 2d 346, 156 USPQ 406 (Cl. Cl. 1967).

When applying 35 U.S.C. § 103, the following tenets of patent law must be adhered to:

- (A) The claimed **invention must be considered as a whole;**
- (B) The **references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;**
- (C) The references must be viewed **without the benefit of impermissible hindsight** vision afforded by the claimed invention; and
- (D) **Reasonable expectation of success is the standard** with which obviousness is determined.

Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986) (emphasis added).

SUBSTANTIAL EVIDENCE IS REQUIRED TO SUPPORT ALL REJECTIONS

Further, in Dickinson v. Zurko, 119 S. Ct. 1816, 50 USPQ2d 1930 (1999), the Supreme Court held that in reviewing patentability, a reviewing court must apply the standards set forth in the Administrative Procedure Act ("APA") at 5 U.S.C. § 706 (1994), see Zurko, 119 S. Ct. at 1818, 50 USPQ2d at 1931-32.

Section 706 reads in relevant part as follows:

"§ 706. Scope of Review

The reviewing court shall--

(2)hold unlawful and set aside agency action, findings, and conclusions found to be--

(A)arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law;

(E)unsupported by substantial evidence in a case subject to sections 556 and 557 of this title or otherwise reviewed on the record of an agency hearing provided by statute."

5 U.S.C. § 706(2)(A), (E) (1994) (emphasis added).

Subsequently, in In Re Gartside, the Court of Appeals for the Federal Circuit held that section 144 explicitly provides that a court must review Board decisions "on the record" developed by the PTO (see 35 U.S.C. § 144 (1994) ("The United States Court of Appeals for the Federal Circuit shall review the decision from which an appeal is taken on the record before the Patent and Trademark Office.") (emphasis added)), and it is for this reason that the Commissioner is required to convey the record to the court in the event of an appeal. See Id. § 143. Moreover, the "hearing" upon which the "record" is based is "provided by" 35 U.S.C. § 7(b), which states that:

"The Board of Patent Appeals and Interferences shall, on written appeal of an applicant, review adverse decisions of examiners upon applications for patents and shall determine priority and patentability of invention in interferences declared under section 135(a) of this title. Each appeal and interference shall be heard by at least three members of the Board of Patent Appeals and Interferences, who shall be designated by the Commissioner. Only the Board of Patent Appeals and Interferences has the authority to grant rehearings."

35 U.S.C. § 7(b) (1994) (emphasis added). Thus, the plain language of §§ 7 and 144 of Title 35 indicates that the courts must review Board decisions "on the record of an agency hearing provided by statute," and that they must therefore review Board factfinding for "substantial evidence." See also Thomas Leonard Stoll, A Clearly Erroneous Standard of Review, 79 J. Pat. & Trademark Off. Soc'y 100, 106 (1997) (arguing in favor of "substantial evidence" review based on 35 U.S.C. §§ 7(b) and 144).

Further, in Gartside, the Court of Appeals for the Federal Circuit stated that:

"In appeals from the Board, we have before us a comprehensive record that contains the arguments and evidence presented by the parties, including all of the relevant information upon which the Board relied in rendering its decision.

*See 35 U.S.C. § 143 (1994) ("[T]he Commissioner shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the Patent and Trademark Office."). That record, when before us, is closed, in that the Board's decision must be justified within the four corners of that record. The record before us on appeal thus dictates the parameters of our review. We cannot look elsewhere to find justification for the Board's decision. Furthermore, the record reflects the results of a proceeding in the PTO during which the applicant has been afforded an opportunity to bring forth the facts thought necessary to support his or her position. Accompanying the record is a detailed opinion from the Board. We have expressly held that the Board's opinion must explicate its factual conclusions, enabling us to verify readily whether those conclusions are indeed supported by "substantial evidence" contained within the record. See *Gechter v. Davidson*, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) ("[W]e hold that the Board is required to set forth in its opinions specific findings of fact and conclusions of law adequate to form a basis for our review.").*

*In addition to the statutory language discussed above, Supreme Court precedent and the law of our sister circuits also indicate that "substantial evidence" review is appropriate in view of the plenary nature of the record before us. The Supreme Court has stated generally that the "basic requirement" for "substantial evidence" review is that the agency hearing produce a record that serves as the foundation for the agency's action. See *Overton Park*, 401 U.S. at 415; *Camp v. Pitts*, 411 U.S. 138, 141 (1973) (noting that "substantial evidence" review "is appropriate when reviewing findings made on a hearing record"). In *Zurko* the Court echoed these prior decisions when it intimated that "substantial evidence" review is the appropriate standard for our review of Board factfinding. See *Zurko*, 119 S. Ct. at 1823, 50 USPQ2d at 1936 ("A reviewing court reviews an agency's reasoning to determine whether it is 'arbitrary' or 'capricious,' or, if bound up with a record-based factual conclusion, to determine whether it is supported by 'substantial evidence.'"). . . .*

Because our review of the Board's decision is confined to the factual record compiled by the Board, we accordingly conclude that the "substantial evidence" standard is appropriate for our review of Board factfindings. See 5 U.S.C. § 706(2)(E)."

See generally *In Re Robert J. Gartside and Richard C. Norton*, 99-1241 Interference No. 103,255 (Fed. Cir. 2000).

Thus, to establish a *prima facie* case of obviousness, the Examiner is required to cite a combination of prior art that not only teaches each and every element of the rejected claims, but also is required to cite substantial evidence to support the conclusion that one of ordinary skill in the art would be motivated to combine or modify the references as suggested, as well as substantial evidence that one of ordinary skill in the art would have a reasonable expectation of success in making the cited combination or modification.

ARGUMENTS

(A) When Considered As A Whole, The Invention of Applicant's Claims 4, 5, 11 & 12 Is Non-Obvious.

When applying 35 U.S.C. § 103, the claimed invention must be considered as a whole. It is respectfully submitted that the rejection is overcome by the amendment of claims 1 and 8. When the invention of the claims is considered as a whole, clearly Crain does not teach each and every limitation of Applicant's claims, because Crain does not teach or suggest a fastener comprising a **removable unitary assembly** that is quickly and easily installed or removed as a one-piece (*i.e.*, "unitary") assembly. It is respectfully submitted that the rejection is thus overcome. Reconsideration and withdrawal of the obviousness rejection of claims 4, 5, 11 and 12 are therefore earnestly requested.

(B) The Prior Art Of Record Does Not Suggest Crain Should Be Modified Or Teach The Subject Matter Of Claims 4, 5, 11 & 12.

When applying 35 U.S.C. § 103, the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination. Thus, in determining obviousness, the basic issue is whether applied references, alone or in any combination, suggest the claimed invention as a solution to the specific problem solved. When the prior art itself does not suggest or render obvious the claimed solution to that problem, the art involved does not satisfy the criteria of 35 USC § 103 for precluding patentability. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. Carela v. Starlight Archery, 231 USPQ 644 (Fed. Cir. 1986).

Applicant's invention provides a novel solution to the problem of quickly and easily exchanging the head and/or shaft of a modern lacrosse stick, by providing a removable unitary assembly designed specifically for this purpose. Crain does not address this problem, rather, Crain addresses the problem of interlocking extensible and retractable telescopic tubes. Thus, Crain addresses a different problem. Moreover, as explained above, Crain does not disclose, teach or suggest a fastener comprising a **removable unitary assembly** that is easily installed or removed as one piece (*i.e.*, "unitary"). More particularly, the locking mechanism of Crain clearly is located within an internal plug, which is integral with and affixed inside the inner section of tubing. Indeed, the plug is affixed in place and entirely inaccessible, since it is located inside the end of the inner tube section, thus it is not removable as a unitary assembly.

Further, the Examiner modifies the features of Crain to reject the present claims. Applicant respectfully points out several problems with this combination.

Furthermore, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Rutti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 123 USPQ at 352.).

Applicant's specification discloses a fastener comprising a removable unitary assembly, which is easily installed or removed as a complete unit (see, *e.g.*, drawing and specification at page 5, lines 1-13). Crain, on the other hand, requires detent pin 27 (constituting detent means) to be mounted in a diametrical bore 29 of plug 15, which must be affixed at one end of the inner tubular section. Thus, the proposed modification would change the principle of operation of Crain, and therefore the teaching of Crain is not sufficient to render the claims *prima facie* obvious. *Id.*

It is respectfully submitted that the rejection is thus overcome. Reconsideration and withdrawal of the obviousness rejection of claims 4, 5, 11 and 12 are therefore earnestly requested.

(C) The Examiner Is Using Impermissible Hindsight Vision Afforded By Applicant's Disclosure.

When applying 35 U.S.C. § 103, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. When features of prior art references are combined to establish obviousness, the mere possibility of such a combination does not render the result of that combination obvious absent a logical reason of record which justifies the combination. *In re Regel*, 526 F.2d 1399, 188 USPQ 136 (CCPA 1975). Instead, references may only be modified or combined when (1) the prior art would have suggested to

those of ordinary skill in the art that they should make the claimed product or perform the claimed process, and (2) that those of ordinary skill in the art would have a reasonable expectation of success of making the claimed composition or performing the claimed process. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Thus, there must be a reason apparent to one skilled in the art at the time of the invention for applying the teaching at hand, or the use of the teaching as evidence of obviousness entails prohibited hindsight. Graham v. John Deere Co., 383 US 1, 148 USPQ 459 (1966). A fairly recent case from the Court of Appeals for the Federal Circuit amplifies this basic tenet and is quoted at length here.

"Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine]" as an "essential evidentiary component of an obviousness holding"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("the Board must identify specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them"); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination "only by showing some objective teaching [leading to the combination]"); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (evidence of teaching or suggestion "essential" to avoid hindsight); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 297, 227 USPQ 657, 667 (Fed. Cir. 1985) (district court's conclusion of obviousness was error when it "did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination"). See also Graham, 383 U.S. at 18, 148 USPQ at 467 ("strict observance" of factual predicates to obviousness conclusion required). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight. See, e.g., Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time."). In this case, the Board fell into the hindsight trap.

We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg. v. SGS Imports Intern., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," Rouffet, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for

actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard, 157 F.3d at 1352, 48 USPQ2d at 1232. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact."); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977) ("The examiner's conclusory statement that the specification does not teach the best mode of using the invention is unaccompanied by evidence or reasoning and is entirely inadequate to support the rejection."). In addition to demonstrating the propriety of an obviousness analysis, particular factual findings regarding the suggestion, teaching, or motivation to combine serve a number of important purposes, including: (1) clear explication of the position adopted by the Examiner and the Board; (2) identification of the factual disputes, if any, between the applicant and the Board; and (3) facilitation of review on appeal. Here, however, the Board did not make particular findings regarding the locus of the suggestion, teaching, or motivation to combine the prior art references."

In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

First, it is duly noted that, in order to establish a *prima facie* case of obviousness, the Examiner must establish that the prior art provides some teaching, suggestion or motivation to combine or modify the cited references, as described in Applicant's disclosure, otherwise, the Examiner is using impermissible hindsight to reject the claims. Further, the Examiner must show that one of ordinary skill in the art would have a reasonable expectation of success in making the claimed invention. Secondly, it is noted that the Examiner is required to support the obviousness rejection with actual evidence, as opposed to mere Examiner's arguments. See In re Zurko, 142 F.3d 1447, 46 USPQ2d 1691 (Fed. Cir., 1998); Dickinson v. Zurko, 119 S. Ct. 1816, 50 USPQ2d 1930 (1999); In Re Robert J. Gartside and Richard C. Norton, 99-1241 Interference No. 103,255 (Fed. Cir. 2000).

It is respectfully submitted that there is no evidence of any motive taught in the prior art to modify Crain, as the Examiner suggests, either disclosed or suggested anywhere in the prior art of record. Indeed, the Examiner has not provided any evidence whatsoever addressing the level of skill of a person of ordinary skill in the pertinent art, nor any evidence to support the assertion that there is a motivation taught in the prior art to modify the reference as suggested.

There is no teaching or suggestion in the prior art of record that one of ordinary skill in the art would be motivated to modify Crain to make a fastener comprising a removable unitary assembly, or that one of ordinary skill in the art would have a reasonable expectation of success in making such modifications. The only evidence of record teaching a fastener comprising the

removable unitary assembly of Applicant's claims, which is easily installed or removed as a one-piece (*i.e.*, "unitary") assembly, is Applicant's specification. Thus, Applicant respectfully submits that the obviousness rejection is based on impermissible hindsight

It is respectfully submitted that the rejection is thus overcome. Reconsideration and withdrawal of the obviousness rejection of claims 4, 5, 11 and 12 are therefore earnestly requested.

(D) The Evidence Record Shows No Reasonable Expectation Of Success.

It is respectfully submitted that the evidence of records does not show that one of ordinary skill in the art would have a reasonable expectation of success in making the modifications suggested by the Examiner. Indeed, the Examiner has not provided any evidence whatsoever to show that one of ordinary skill in the art would have a reasonable expectation of success. The only evidence of record shows that there was no reasonable expectation of success. See Declaration of Richard A. Enos, attached hereto. It is respectfully submitted that the rejection is thus overcome. Reconsideration and withdrawal of the obviousness rejection of claims 4, 5, 11 and 12 are therefore earnestly requested.

(E) Applicant's Evidence of Secondary Considerations Shows That Claims 1-22 Are Non-Obvious.

When applying 35 U.S.C. § 103, objective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts **are relevant to the issue of obviousness and must be considered in every case in which they are present.** Affidavits or declarations containing evidence of criticality or unexpected results, commercial success, long-felt but unsolved needs, failure of others, skepticism of experts, *etc.*, must be considered by the Examiner in determining the issue of obviousness of claims for patentability under 35 U.S.C. § 103. The Court of Appeals for the Federal Circuit stated in Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983) that "evidence rising out of the so-called 'secondary considerations' must always when present be considered en route to a determination of obviousness." Such evidence might give light to circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or unobviousness, such evidence may have relevancy. Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966); In re

Palmer, 451 F.2d 1100, 172 USPQ 126 (CCPA 1971); In re Fielder, 471 F.2d 640, 176 USPQ 300 (CCPA 1973).

When evidence of any of these secondary considerations is submitted, the examiner must evaluate the evidence. All of the competent rebuttal evidence taken as a whole should be weighed against the evidence supporting the *prima facie* case. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The ultimate determination on patentability is made on the entire record. In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

Attached hereto is the Declaration of Richard A. Enos under 37 C.F.R. 1.132, providing evidence of secondary considerations weighing heavily in favor of non-obviousness, including criticality or unexpected results, commercial success, long-felt but unsolved needs, failure of others, copying by others, licensing, and skepticism of experts. It is respectfully submitted that a careful review of the secondary considerations shows that claims 1-22 are non-obvious over Crain.

It is respectfully submitted that Crain does not teach or suggest Applicant's independent claims 1 and 8, because the reference does not disclose each and every limitation of the claims, there is no teaching or suggestion in the prior art to modify Crain, there is no likelihood of success, and taken together with the evidence regarding secondary considerations of non-obviousness, the whole of the record clearly shows that the claims are not obvious in view of the prior art.

Dependent claims 4, 5, 11 and 12, being dependent upon and further limiting independent claims 1 and 8, should be allowable for the same reason, as well as the additional limitations recited therein. Reconsideration and withdrawal of the rejection of claims 4, 5, 11 and 12 as being obvious over Crain are therefore respectfully requested.

Claims 15 and 17-19 were rejected under 35 U.S.C. § 103 (a) as being obvious over Lewis, Jr. (US) in view of Crain (US 4,385,849).

Applicant respectfully disagrees, and maintains that the claims, as amended, are patentable over Lewis, Jr. and Crain, individually and in combination, for the reasons given above in respect to the section 102 rejection of claims 1, 3, 6, 8 and 10 and the section 103 rejection of claims 4, 5, 11 and 12. The arguments above as to the novelty and non-obviousness of claims 1, 8 and 15 is repeated here by reference. It is respectfully submitted that the rejection is overcome by the amendment of claim 15 and the foregoing remarks.

Also as noted above, it is respectfully submitted that the Examiner has not met the initial burden of making a proper *prima facie* showing of obviousness. More particularly, the Examiner asserts that one of ordinary skill in the art would be motivated to modify Crain and combine it with Lewis, Jr., and would have a reasonable expectation of success in making Applicant's invention, however, the Examiner cites absolutely no authority in support of such factual assertions. If the Examiner's assertions are intended to indicate that the obviousness rejection is based on common knowledge in the art or "well known" prior art under MPEP 2144.03, then Applicant hereby traverses the Examiner's assertions.

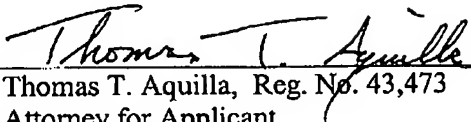
It was previously noted that Crain does not address the same problem as Applicant's invention. It is further noted that the prior art of record does not teach or suggest that Lewis, Jr. and Crain should be combined to make a fastener comprising the removable unitary assembly of Applicant's claims, which is easily installed or removed as a one-piece (*i.e.*, "unitary") assembly. Nor does the prior art of record teach that one of ordinary skill in the art would have a reasonable expectation that such combination would successfully resolve the problem of quickly and easily exchanging the head and/or shaft of a modern lacrosse stick. Further, it is noted that Lewis, Jr. does not cure the deficiencies of Crain, because Lewis, Jr. merely teaches a lacrosse stick, and the only fastener disclosed is a machine screw. There is no teaching or suggestion in Lewis, Jr. of a lacrosse stick having the fastener of Applicant's claim 15. Thus, Lewis, Jr. does not cure the deficiencies of Crain, and similarly also does not address the same problem as Applicant's invention.

It is respectfully submitted that the rejection of claim 15 is thus overcome. Dependent claims 17-19, being dependent upon and further limiting independent claim 15, should be allowable for the same reasons, as well as the additional limitations recited therein. Reconsideration and withdrawal of the rejection of claims 15 and 17-19 as being obvious over Lewis, Jr. in view of Crain are therefore respectfully requested.

Applicant believes the claims, as amended, are patentable over the prior art, and that this case is in condition for allowance of all claims therein. Such action is thus respectfully requested. If the Examiner disagrees, or believes for any other reason that direct contact with Applicant's attorney would advance the prosecution of the case to finality, he is invited to telephone the undersigned at the number given below.

"Recognizing that Internet communications are not secured, I hereby authorize the PTO to communicate with me concerning any subject matter of this application by electronic mail. I understand that a copy of these communications will be made of record in the application file."

Respectfully Submitted:
Richard A. Enos

By: 
Thomas T. Aquilla, Reg. No. 43,473
Attorney for Applicant

Brown & Michaels, PC
400 M&T Bank Building - 118 North Tioga Street
Ithaca, New York 14850
(607) 256-2000 • (607) 256-3628 (fax)
e-mail: aquilla@bpmlegal.com

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